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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/599,053      | 06/21/2000  | Rodric C Fan         | M-9199US            | 6523             |

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3662     |              |

DATE MAILED: 04/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 09/599,053      | FAN ET AL.   |
| Examiner                     | Art Unit        |              |
| Gregory C. Issing            | 3662            |              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 January 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmier et al.

Schmier et al teach the location relevant service substantially as claimed including a service server/service bureau 22 accessible over a data network, a first mobile unit 12 (bus, e.g.) having a GPS receiver 14 for determining position and communicating such to the central processor 22, and a second mobile unit 31 (user PDA/pager) receiving location relevant information of the first mobile vehicle 12, including news, weather, announcements, advertising and adjusted time tables for connecting buses. Such information makes obvious the enabling of business transactions at the second mobile unit via the fact that the mobile unit is made aware of sales or snack bars in the approaching vicinity as well as adjusted times and points for connecting buses.

3. Applicant argues that Schmier et al fail to teach enabling a business transaction to be carried out. However, this is not convincing in view of the fact that Schmier et al clearly makes obvious that the second mobile user is made aware of advertisements and bus exchanges, for example, on the basis of the location of the first mobile unit, i.e. the bus. Each of the advertising and bus exchange information enables the user to carry out a business transaction by getting off and visiting the store having the advertisement or to exchange buses and ride a different route.

With regard to the applicants' argument to claim 23, route information inherently includes "driving directions".

4. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girerd et al.

Girerd et al teach a client server based remote locator device including a first mobile unit (sensor 20) having a GPS receiver 220 and a transceiver 222, a second mobile unit (client 1) and a data network 5/10. The client 1 is described as a laptop computer that accesses information provided by a location-relevant service server based on the position of the first mobile unit. The sensor communicates position to the server; the server analyzes the position and can index it to GIS information; and the user receives the GIS information from the server regarding the position of the sensor. The enabling of a business transaction is made obvious in view of the fact that the client user may be charged for use of the location service; thus, the use of the location relevant information requires a service charge be charged to the client and meets the scope of the claim for enabling a business transaction.

5. Applicants argue that Girerd et al do not disclose a second mobile unit. This is not convincing since client computer 1 is described as being a laptop computer which is a mobile unit. Applicants argue that the business transaction is not taught by Girerd et al. Again, this is not persuasive since the use of the location service is described as possibly being a fee-based system; thus, use of the system enables a business transaction.

6. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertsis.

Bertsis the location relevant service system substantially as claimed including a first, in-vehicle, mobile unit 45/58, a second mobile unit PDA 12 and a data network server platform 40.

In view of the use of the server to provide billing via its value-added server, the enabling of a business transaction is at least obvious, if not inherent.

7. Applicants argue that Bertsis does not disclose two mobile units. This is not convincing since the GPS receiver and wireless transmitter are in-vehicle components whereas the PDA is a user portable device which can be attached to a cradle residing in the mobile vehicle. Applicants argue that Bertsis does not disclose a server accessible over a data network. This is not persuasive since the server platform is described as a WEB/application server connected to the Internet as well as connectable to value-added servers. Applicant argues that Bertsis does not disclose the business transaction claimed. In view of the fact that the server platform provides value added functions, including billing functions, the enabling of a business transaction on the basis of location relevant data is made obvious. Lastly, applicants allege that Bertsis does not teach the second unit obtaining position of the first unit directly from the first unit. However, in view of the fact that the PDA is coupled to a cradle connected between each of the GPS receiver and the PDA, the PDA is deemed to have the capability of directly receiving the position information. Thus, the applicants' arguments are not convincing.

8. Claims 1-27 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beckert et al in view of Fan et al.

Beckert et al teach a first mobile unit 64 which includes a navigation system 112 (GPS), a second mobile unit faceplate 60. Beckert et al teach the use of stored, downloadable data to provide map/navigation functions but fails to specify the use of the Internet as a source of navigational information. It is well known to utilize a wireless connection to a data network such as the Internet to access a wide variety of information useful for navigational processing,

such as map data, traffic or weather conditions as well as to provide third party monitoring of position/operational characteristics as shown by Fan et al. it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Beckert et al by utilizing the faceplate cellphone to wirelessly access a data network such as the Internet to obtain updated map and traffic information as well as to provide third party tracking in view of the teachings of Fan et al.

9. Applicants argue that Beckert et al do not disclose two mobile units. This is contrary to the teachings of Beckert et al since the faceplate is completely operable when separated from the computer module. The computer module is part of the vehicle which clearly is a mobile unit while the faceplate is an operable portable device which is likewise mobile. It is not clear how the applicants' argument that "Beckert does not disclose the cellular telephone communication functionality being integrated with the navigation system" distinguishes the claimed subject matter. The rejection is based on the combination of references wherein the secondary references suggest the downloading/retrieval of data from a remote server via the Internet as well as the use of conventional communication links to provide such data. The downloading of data from the faceplate to the computer module in Beckert et al is taught via the IrDA port. The combination makes obvious the use of the suggested cell phone connection to retrieve data from a data network in view of communicated position. The computer module reads on the first mobile unit and provide position information for navigational purposes. The faceplate module reads on the second mobile unit and includes a wireless communication link. Fan et al teach the wireless communication of position information to a remote server to access information. The second mobile unit utilizes its wireless link via the cell phone to communicate position

information to a remote server as taught by Fan et al in order to access pertinent information.

Applicants also argue that the combination fails to suggest the business transaction as claimed.

However, Beckert et al teach the inclusion of banking/financial applications. Thus, the applicants' arguments are not convincing.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

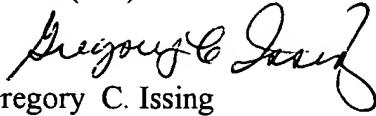
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-7687 for regular communications and (703) 305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Gregory C. Issing  
Primary Examiner  
Art Unit 3662

gci  
April 3, 2002